UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,257	10/26/2001	Ty Sagalow	10251-054	1020

21890 7590 03/08/2006	EXAMINER
PROSKAUER ROSE LLP PATENT DEPARTMENT 1585 BROADWAY NEW YORK, NY 10036-8299	GLASS, RUSSELL S

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on <u>26 October 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-9</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-9</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1.   Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent

form for failing to further limit the subject matter of a previous claim. In particular, claim

4 deletes the limitation of completing an online self-assessment, thus broadening the

scope of the invention in claim 1. Applicant is required to cancel the claim(s), or amend

the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in

independent form.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

2.   Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. In Particular, claim 4 is in dependent form and fails to contain

a reference to claim 1 previously set forth, and fails to specify a further limitation of the

subject matter claimed. A claim in dependent form shall be construed to incorporate by

reference all the limitations of the claim to which it refers.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1, 3, 4, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer, (U.S. Pub. 2002/0116228) in view of Jeffery A. Siderius, *Insurance For Electronic Data Risks: An Idea Whose Time Has Come?*, Mealey's Technology Litigation and Insurance, March 1999, Vol. 1, #1, at 1-4, ("Siderius").

4.   As per claim 1, Bauer discloses a method for selling an insurance product online to a user, comprising the steps of:

a.   offering an online application to said user, said online application having a menu of available internet insurance coverages, (Bauer, Fig. 3; ¶ 97, 101),

b.   upon said user completing said online application, offering an online self-assessment rating engine to said user, (Bauer, Fig. 4; ¶ 102),

c.   upon said user completing an online self-assessment, offering an online quote request form to said user(Bauer, Fig. 4; ¶ 102),

d.   upon said user completing said online quote request form for a particular set of internet insurance coverages, performing a risk analysis on said user, (Bauer, Fig. 4; ¶ 102),

e.   upon satisfactorily completing said risk analysis, offering an online quote for said particular set of internet insurance coverages to said user, (Bauer, ¶ 5, 102),

f.   upon said user accepting said online quote, selling said particular set of internet insurance coverages to said user, (Bauer, ¶ 101, claim 4).

Bauer fails to disclose selling an internet insurance product. However, internet insurance is well-known in the art as evidenced by Siderius. Siderius discloses insurance for protecting against the risk of "a hacker gaining unauthorized access to a company's internal computer network and altering or destroying the company's key data.", (Siderius, p. 1, ¶ 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bauer and Siderius. The motivation would have been to make internet insurance more rapidly accessible to customers, (Siderius, p. 1, ¶ 4).

5.   As per claim 3, Bauer discloses the wherein said risk analysis is performed online, (Bauer, ¶ 102, 103).

The motivation to combine Bauer and Siderius is as provided in the rejection of claim 1 and incorporated herein by reference.

6.   As per claim 4, Bauer discloses the method wherein said user requests a quote without completing an online self-assessment, (Bauer, ¶ 102, 103).

The motivation to combine Bauer and Siderius is as provided in the rejection of claim 1 and incorporated herein by reference.

7.   As per claim 7, Bauer discloses the method wherein said user has access to specimen policies, (Bauer, ¶ 97).

The motivation to combine Bauer and Siderius is as provided in the rejection of claim 1 and incorporated herein by reference.

8.   As per claim 8, Bauer discloses wherein said user has access to status information regarding his quote request, (Bauer, ¶ 22).

The motivation to combine Bauer and Siderius is as provided in the rejection of claim 1 and incorporated herein by reference.

9.   Claims 2, 5, 6, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the collective system of Bauer and Siderius as applied to claim 1 above, and further in view of Luchs, (U.S. 4,831,526).

10.   As per claim 2, the collective system of Bauer and Siderius fail to discloses the method wherein said risk analysis is performed off-line.

However, such method is well-known in the art as shown by Luchs. Luchs discloses the method of claim 1 wherein said risk analysis is performed off-line, (Luchs, Col. 4, lines 44-60; Col. 8, lines 12-16; Col. 9, line 55 - Col. 10, line 66; col. 16, line 42- Col. 17, line 5; Col. 17, lines 45-65)(underwriting is considered risk analysis).

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the collective system of Bauer and Siderius with Luchs. The motivation would be to retrieve or generate data to further define the risk, such data being reports, inspections, appraisals, quality control reports, and other risk-control measures. (Col. 8, lines 12-16; Col. 9, line 55 - Col. 10, line 66; col. 16, line 42- Col. 17, line 5; Col. 17, lines 45-65).

11.   As per claim 5, the collective system of Bauer and Siderius fails to disclose the method wherein said risk analysis includes an onsite security assessment of said user.

However, such method is well-known in the art as shown by Luchs. Luchs discloses method of claim 1 wherein said risk analysis includes an onsite assessment of

the subject matter to be insured, such as an inspection, appraisal, or other risk-control

measure, (Luchs, Col. 4, lines 44-60; Col. 8, lines 12-16; Col. 9, line 55 - Col. 10, line

66; col. 16, line 42- Col. 17, line 5; Col. 17, lines 45-65). It would be obvious to provide

an onsite security assessment of electronic data if the subject matter to be insured was

electronic data.

It would be obvious to one of ordinary skill in the art at the time of the invention to

combine the collective system of Bauer and Siderius with Luchs. The motivation would

be to retrieve or generate data to further define the risk, such data being reports,

inspections, appraisals, quality control reports, and other risk-control measures. (Col. 8,

lines 12-16; Col. 9, line 55 - Col. 10, line 66; Col. 16, line 42- Col. 17, line 5; Col. 17,

lines 45-65).

12.   As per claim 6, the collective system of Bauer and Siderius fails to disclose the

method wherein said onsite security assessment determines whether or not the user is

approved for said online quote.

However, such method is well-known in the art as shown by Luchs. Luchs

discloses the method of claim 5 wherein said onsite security assessment determines

whether or not the user is approved for said online quote, (Luchs, Col. 16, line 42- Col.

17, line 5; Col. 17, lines 45-65).

It would be obvious to one of ordinary skill in the art at the time of the invention to

combine the collective system of Bauer and Siderius with Luchs. The motivation would

be to retrieve or generate data to further define the risk, such data being reports,

inspections, appraisals, quality control reports, and other risk-control measures. (Col. 8,

lines 12-16; Col. 9, line 55 - Col. 10, line 66; col. 16, line 42- Col. 17, line 5; Col. 17,

lines 45-65).

13.   As per claim 9, the collective system of Bauer and Siderius fails to disclose the

wherein said user has access to a call center.

However, such method is well-known in the art as shown by Luchs. Luchs

discloses the method of claim 9 wherein said user has access to a call center, (Luchs,

Fig. 1; Col. 13, lines 64-68).

It would be obvious to one of ordinary skill in the art at the time of the invention to

combine the collective system of Bauer and Siderius with Luchs. The motivation would

be to collect user data over the telephone as well as the internet to further define the

risk, such data being reports, inspections, appraisals, quality control reports, and other

risk-control measures. (Luchs, Fig. 1; col. 13, lines 64-68; Col. 8, lines 12-16; Col. 9,

line 55 - Col. 10, line 66; col. 16, line 42- Col. 17, line 5; Col. 17, lines 45-65).

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure is as follows: Cianciarulo et al., (U.S. 6,922,720); Bosco et al.,

(U.S. 5,191,522); Tyler et al., (U.S. 5,523,942); and Bourgesi et al., (U.S. 5,950,169).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Russell S. Glass whose telephone number is 571-272-

3132. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

RSG
11/17/05
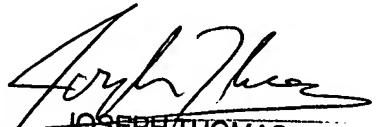
JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER